

REMARKS

Status of Claims

Claims 1, 3-20, 30, 32-35, 43, and 44 are pending in this application. By this Amendment, claims 1, 3-6, 18, 30, 43, and 44 have been amended, claims 36-42 have been canceled. Reconsideration is respectfully requested in view of the above Amendments and the following remarks.

Rejection under 35 U.S.C. §112

Claim 44 has been rejected under 35 U.S.C. §112, second paragraph, as being indefinite. Claim 44 has been amended to expedite the prosecution and correct any existing deficiencies. Accordingly, withdrawal of the rejection is respectfully requested.

Rejections under 35 U.S.C. §102

Claims 36-42 stand rejected under 35 U.S.C. § 102(a) as being anticipated by U.S. Patent No. 6,338,046 to Saari et al. (hereinafter "Saari"). Claims 36-42 have been canceled without prejudice or disclaimer in order to expedite the prosecution. Accordingly, the rejection is moot and its withdrawal is respectfully requested.

Claim 44 has been rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,086,618 to Al-Hilali et al. (hereinafter "Al-Hilali"). This rejection is respectfully traversed.

Al-Hilali fails to disclose each and every feature of claim 44. Al-Hilali discloses a system and method for estimating resource usage in order to avoid server overloads that result in inadequate availability of resources to users. The system of Al-Hilali discloses a

technique that a provider can use to estimate resource usage and thus purchase hardware and other resources in accordance with the estimate. The model of Al-Hilali provides techniques for estimating usage and does not actually measure monetary costs to a service provider. Accordingly, Al-Hilali fails to disclose a system for assigning a monetary cost to a computer transaction. Al-Hilali also fails to disclose a cost assessment component for determining a monetary cost to a provider for each resource and for determining the monetary cost for the computer transaction based on a total monetary service provider cost for each utilized resource.

Because Al-Hilali fails to disclose each and every feature of the invention of claim 44, Al-Hilali fails to anticipate claim 44. Withdrawal of the rejection of claim 44 under 35 U.S.C. §102 is therefore respectfully requested.

Rejections under 35 U.S.C. §103

Claims 1-3, 3-20, 30, 32-35, and 43 have been rejected under 35 U.S.C. §103 over Saari in view of Al-Hilali. This rejection is respectfully traversed.

With respect to independent claim 1, even if combined, Saari and Al-Hilali fail to result in the claimed invention. As recognized in the Office Action, Saari fails to disclose determining a providing cost by identifying each resource utilized to provide a service, assigning a portion of the providing cost of each resource to the computer transaction, and summing the providing cost for each resource to determine a providing cost for the computer transaction. Further, Saari fails to disclose summing the monetary service providing cost for each resource to determine the monetary cost for the computer

transaction in order to pass the monetary cost for the computer transaction to a user executing the computer transaction.

Saari discloses a technique for determining charges for use of a network service connection. The technique of Saari allows independent network operators 22 at different locations 24 to combine charges. In column 4, lines 31-35, Saari provides a laundry list of possible charging formulae including "service class type, quality of service, any individual or combination of ATM parameters, connection time, and other traffic flow parameters." Each operator sends a billing cell 31 and a billing unit at each node 24 can calculate the charges. The billing cell 31 may contain a header 36, address information 25, and connection information 38. See Column 5, lines 11-22 of Saari. The connection information 38 may include class of service, cell loss ratio, maximum peak rate, and level of service. See Column 5, lines 60-67 of Saari.

Saari is not concerned with identifying a cost associated with the individual underlying resources necessary for providing a service. Saari merely identifies parameters of the service itself, such as "connection time" or "quality". As further set forth in the dependent claims, the resources include such items as facilities, equipment, and personnel. Saari is not concerned with identifying these resources and additionally is not concerned with determining a cost associated with each resource in order to assign a portion of the cost to each computer transaction as defined in claim 1.

As set forth above, Al-Hilali discloses system and method for estimating resource usage in order to avoid server overloads that result in inadequate availability of resources to users. The system of Al-Hilali discloses a technique that a provider can use to estimate

resource usage and thus purchase hardware and other resources in accordance with the estimate. The model of Al-Hilali provides techniques for estimating usage and does not actually measure monetary costs to a service provider.

Accordingly, Al-Hilali also fails to disclose a method for assigning a monetary cost to a computer transaction. "Costs" as defined by Al-Hilali do not include monetary costs and are not passed to a user executing a computer transaction. Costs as defined by Al-Hilali are defined in MHz in KB. See tables 3-5 in Column 16 of Al-Hilali. Al-Hilali's costs are resource quantities. Furthermore, Al-Hilali is not concerned with passing costs per computer transaction onto a user. Instead, Al-Hilali combines all information about users in a user profile 154 so that total resource expenditure can be estimated for the benefit of service provider planning.

Whereas claim 1 is concerned with identifying the cost of resources utilized to provide a service, the disclosure of Saari is concerned only with the service costs themselves and the passing along of the service costs to different network operators. Al-Hilali is not concerned with monetary costs and is instead only concerned with estimating resource usage for the benefit of a service provider in order to enable the service provider to purchase adequate hardware.

Accordingly, both Saari and Al-Hilali fail to disclose determining a monetary service providing cost associated with the one or more services utilized to execute a computer transaction, wherein determining the monetary service providing cost comprises identifying each resource utilized to provide the one or more services and assigning a portion of the monetary service providing cost of each resource to the

computer transaction. Both Saari and Al-Hilali further fail to disclose summing the monetary service providing cost for each resource to determine the monetary cost for the computer transaction in order to pass the monetary cost for the computer transaction to a user executing the computer transaction.

In order to make out a prima facie case of obviousness, the references cited by the Examiner must provide all of the elements of the invention as claimed and a suggestion to combine the disclosures of the various cited art references to make the claimed invention. *In re Geiger*, 815 F.2d 686,688 2 USPQ2d 1276, 1278 (Fed. Cir. 1987); *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984).

Furthermore, in order to make a prima facie case of obviousness, a teaching or suggestion of the combination must be found in the prior art. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Neither the disclosure of Saari, nor the disclosure of Al-Hilali provides any suggestion for the combination. Furthermore, the prior art as a whole would not have provided such a suggestion since the two references are directed to completely different purposes.

Claims 3-20 depend from claim 1 and define further distinctive features of the invention. Accordingly, claims 3-20 are allowable over the art of record for at least the reasons set forth above with respect to claim 1. Furthermore, contrary to the allegations in the Office Action, Saari and Al-Hilali fail to disclose many of the additional features in the dependent claims.

With regard to independent claim 30, Saari and Al-Hilali fail to disclose a method in a computer system of executing a computer transaction, comprising determining, by the one or more service processes, a monetary service provider cost associated with the execution of the transaction as a function of the services utilized to execute the transaction. Saari and Al-Hilali further fail to disclose identifying each resource utilized to provide the service and assigning a portion of the monetary service provider cost of each resource to the computer transaction in order to pass the monetary service provider cost to the user executing the computer transaction. Accordingly, even if combined, Saari and Al-Hilali fail to arrive at the invention of claim 30. Furthermore, as set forth above, no motivation would have existed for modifying Saari with the disclosure of Al-Hilali.

Claims 32-35 depend from claim 30 and are allowable over Saari for at least the reasons set forth above with respect to claim 30.

For the reasons set forth above, applicants respectfully submit all of pending claims rejected under 35 U.S.C. §103 are allowable over the art of record. Accordingly, withdrawal of the rejection under 35 U.S.C. §103 is respectfully requested.

CONCLUSION

As set forth above, applicants respectfully submit that all pending claims are in condition for allowance. Applicants respectfully request that this application be allowed and passed to issue. Should however any issues remain prior to issuance of this application, the Examiner is urged to contact the undersigned to resolve the same. The Commissioner is hereby authorized to charge any additional amount required, or credit any overpayment, to Deposit Account No. 19-2112.

Respectfully submitted,

Date:

7/20/2004


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